

unpatentable over U.S. Patent number 5,549,268 issued to Hopwood (the “Hopwood” reference) in view of U.S. Patent Application Publication number 2004/0031899 filed by Costa (the “Costa” reference”).

## **II. Applicant’s Response**

### **A. 35 U.S.C. § 112 Amendments**

Applicant has amended independent Claims 1, 12 and 19 to more particularly set forth the means-plus-function language. Specifically, the language has been amended to reflect the means for attaching the document holder to an object.

### **B. The Present Invention**

One of the novel features of the present invention is that the pivoting attachment is configured to rotate and selectively arcuately lock the arm in at least one predetermined arcuate rotational position with respect to an external object. In other words, the device is rotatable over several pre-determined locking points to provide stability. As shown in FIG. 7, the joint 300 is the corresponding structure which provides such locking. This is preferably accomplished by providing a “base 500 [that] can have two extensions 310 with serrated medial surfaces which rotatably engage a cylinder 320, with corresponding lateral serrations, on one of the stand 200. Specification, p. 8, lns. 11-13. The advantage of providing such arcuate locking is that it provides enhanced frictional engagement and adjustment, that is especially convenient for users who frequently clip objects to or unclip objects from the device yet wish to retain the position of the device. Each time the objects are clipped to or unclipped from the device, the pivoting attachment, being arcuately locked, inhibits unintentional movements that would otherwise

require readjustment to the clip. For example, the mirror on the device can be used to either check one's own complexion, which might only be every once in awhile, or may be used to view who is approaching from behind, i.e. boss, co-worker, secretary, etc. In the latter situation, the device's user would precisely position the mirror to make the entrance to their office, cubicle, or other work area visible to them at a glance. If the user had to readjust the mirror each time he or she clipped a new item to the device, this would take a considerable amount of work and frustration. Yet, the pivoting attachment's selectively arcuately locking feature avoids or reduces the need for such readjustment by keeping the position of the device steady.

**C. The Hopwood Reference Does Not Disclose the Features Asserted by the Examiner.**

Applicant respectfully submits that the Hopwood reference does not contain the features cited by the Examiner and cannot be used as a prior art reference under 35 U.S.C. § 103(a). Specifically, while the Examiner stated that the Hopwood reference includes a "pivoting attachment/second joint (44) capable of rotating and locking (106, 108) the arm in one or more predetermined arcuate rotational positions with respect to the object," the joint 44 does not lock in such a manner.

As understood by Applicant, the "locking members 106 and 108" in the Hopwood reference are merely a pair of tabs which interact with the hinge flanges 66 to "prevent inadvertent withdrawal of the hinge member 44." Hopwood, col. 6, lns. 57-63. This can be more clearly understood in FIGS. 3 and 4. of the Hopwood reference, which shows the details of the elongate assembly inserted into the clip assembly.

It is also understood that the true purpose of the locking members 106 and 108 are to aid

in assembly, not to arcuately lock. In the portion of the specification that describes the locking members 106 and 108, the passage is prefaced with the introduction that “The paper holding device 20 is assembled as follows.” Hopwood, col. 6, lns. 21-22.<sup>1</sup> A close examination of this “how to assemble” section reveals that the purpose of the locking members 106 and 108 is to retain the hinge member 44 and the elongate assembly 30 together in a uniform piece that does not come apart during normal usage and also aids in the assembly thereof. More specifically, the locking members 106 and 108 appear to be configured to prevent axial sliding of the hinge member 44 by making the ends of the hinge member 44 oversized. “Also, as shown in FIG. 4, the effective diameter of the end of the hinge member 44 distal from the elongate assembly 30 is made greater than the diameter of the holes in the flange members by the locking projections 106 and 108.” Hopwood, col. 6, lns. 47-49. Integrating the locking members 106 and 108 into the hinge member 44 also necessitates the formation of notches 100 and 102 to allow for the “leading edge of the hinge member 44 to pass through the holes in the flange members.” Hopwood, col. 6, lns. 53-54. This is further described, and perhaps more succinctly in the following passage:

“During assembly, the portion of the hinge member containing the locking projections is deflected inwardly to allow the hinge member to be inserted into the holes in the rigid members. When the locking projections have passed completely through the holes in the rigid members, the hinge member returns to its original, undeflected configuration, at which point the locking members engage one of the rigid members to prevent withdrawal of the hinge member.” Hopwood, col.2, lns. 44-51 (emphasis added).

Thus, if these locking members 106 and 108 are to be characterized as “locking” at all, their locking appears to be limited to axial locking, not arcuate locking as claimed in the present

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<sup>1</sup>The locking projections 106 and 108 are described in this “how to assemble” section at col. 6, lns. 60-63. The locking projections 106 and 108 are also previously discussed at col. 6, lns. 3-8 but only to state that the projections oppose each other.

invention. Indeed, nothing in the Hopwood reference indicates that the locking projections 106 and 108 could cooperate to provide such selective arcuate locking.

Therefore, Applicant respectfully submits that the Hopwood reference cannot qualify as a proper prior art reference as the basis for a rejection under 35 U.S.C. § 103(a).

**D. There Is No Suggestion to Combine the Hopwood Reference with the Costa Reference.**

Although Applicant believes the Hopwood reference is distinguishable from the present invention, as discussed above, even assuming *arguendo*, Applicant respectfully submits that there is no suggestions to combine the Hopwood reference with the Costa reference. As understood by Applicant, the Hopwood reference is directed toward providing a device that clips objects. The Examiner states that it would have been obvious to modify Hopwood to include a mirror as disclosed in the Costa reference. However, the Examiner fails to cite to any part of the Hopwood specification for technical reasoning or other support indicating that it would have been desirable to modify Hopwood in such a manner. For example, Hopwood states a general desirability for creating identical clips for simpler manufacturing. Adding a mirror to these clips would require a separately manufactured piece which cuts against Hopwood's intention of reducing manufacturing costs, unless all clips were fitted with mirrors, which again, would further increase manufacturing costs.

It is well settled that to modify references, there must be some suggestion to do so, even for simple changes or combinations. See In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) ("Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device

upside down”). In re Gordon, 733 F.3d 900, 902, 221 USPQ 1125, 1227 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). Thus, to modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Even assuming *arguendo*, the Federal Circuit explicitly prohibited “the use of hindsight in the selection of references that comprise the case of obviousness.” Id. At 1358 (citing In re Gorman, 933 F.2d 982, 986 (Fed. Cir. 1991)). More specifically, the Federal Circuit required that the examiner must show reasons that the person in the ordinary skill in the art, when “confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” Id. at 1357. Applicant respectfully submits that such a showing has not been made and that combining the Hopwood and Costa references is at best a result of impermissible hindsight construction. Simply because the Hopwood reference would appear to be capable of such a modification does not provide sufficient legal basis to create obviousness under 35 U.S.C. § 103(a). There, Applicant respectfully submits that there is no suggestion, teaching, or any other disclosure in the Hopwood reference that states a desirability for incorporating a mirror into the clip device and cannot serve as the foundation for a rejection under 35 U.S.C. § 103(a).

The Examiner has the burden of proof when attempting to establish that an allegedly inherent or implied characteristic necessarily flows from the teachings of a prior art reference. In order to meet such a burden, the Examiner must provide a basis in fact, and/or technical reasoning to reasonably support the determination that the allegedly inherent or implied characteristic necessarily flows from the teachings of the prior art reference. Ex parte Levy, 17 U.S.P.Q.2d

1461, 1464 (B.P.A.I. 1990); MPEP 2112. Applicant respectfully submits that no such basis in fact or technical reasoning has been cited in support of the incorporating the mirror disclosed in Costa with the device in Hopwood.

**E. Conclusion**

Other minor amendments were made to the claims to bring further clarity to the same. For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully submitted,

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